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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/731,147

12/10/2003

Hirohito Suda

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08/14/2006

EXAMINER

GELIN, JEAN ALLAND

C. IRVIN MCCLELLAND

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.

1940 DUKE STREET

ALEXANDRIA, VA 22314

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/731,147

Applicant(s)

SUDA ET AL.

Examiner

Jean A. Gelin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,7-9,11,12,15,16 and 20 is/are rejected.
- 7) ☒ Claim(s) 2-6, 10, 13, 14, and 17-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the Applicant's request for continued application (RCE) filed on January 31, 2006 in which claims 1-20 are currently pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1, 7-9, 16, and 20 are rejected under 35 U.S.C. 102(a) as being anticipated by Dadong et al. (EP 1 244 043 A2).

Regarding claims 1, 9, 16, and 20, Dadong teaches a mobile communication terminal (204 fig. 2) comprising: means for receiving identification information from at least one mini-communicator which transmits predetermined identification information of its own (i.e., terminal 204 contains RF receiver 206 for receiving RFID tag from product 200, col. 4, lines 35-45); communicating with a server or another terminal via a cellular communication network (col. 6, lines 1-31); and means for receiving a switching signal for switching among a plurality of modes comprising an identification information receive mode activating only the means for receiving identification information (while receiving the RFID tag), and a cellular communication mode activating only the cellular communication means for communicating (while the mobile terminal transmits the RFID tag over the network), and for performing a mode switching control based on the

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received switching signal (i.e., the controller for controlling the operation of the mobile, col. 4, line 51 to col. 6, line 31).

Regarding claim 7, Dadong teaches means for amplifying a transmitted or received radio wave of the cellular communication network communicable with the mobile communication terminal, to relay the radio wave (i.e., the circuitry of the mobile terminal performing the function of transmitting the receive signal inherently amplify the receive signal prior to transmit it to the network, col. 6, lines 1-31).

Regarding claim 8, Dadong teaches wherein the means for communicating is configured to: set a transmission/reception channel for transmission/reception of the transmission information, separately from a user channel for transmission/reception of user data and a control channel for transmission/reception of a control signal, in communication via the cellular communication network, and transmit the transmission information through the use of the transmission/reception channel (typically, the control channel is used to send command such as sending a page and the user channel voice/data communication are two separate channels, inherently present in cols. 4-6).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 9 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Hamberg (US 2005/0113066).

Note: Hamberg (US 2005/0113066) claims priority date of Feb. 13, 2002.

Regarding claim 9, Hamberg teaches server capable of communication with at least one mobile communication terminal having receiving means for receiving identification information from at least one mini-communicator, and means for communicating with a server or another terminal via a cellular communication network [0025, 0026, 0032, 0038, 0075], the server comprising: means for transmitting to the mobile communication terminal a switching signal according to a predetermined mode switching request, in order to implement switching among a plurality of modes comprising an identification information receive mode activating only the means for receiving identification information, and a cellular communication mode activating only the means for communicating at the mobile communication terminal, and for performing a mode switching control based on the received switching signal [[0104-0109].

Regarding claim 11, Hamberg teaches a mini-communicator location database storing location information of at least one mini-communicator [0020, 0061, 0084-0086]; and location management means for receiving location information of a mini-communicator estimated and notified of by a mobile communication terminal, and for updating the mini-communicator location database by the received location information [0038, 0032-0035, 0146].

Claim Rejections - 35 USC § 103

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dadong in view of Hamberg.

Regarding claim 12, Dadong teaches all the limitations as recited in claim 1 above except wherein the server comprises: means for transmitting a switching signal according to a predetermined mode switching request to the mobile communication terminal and wherein the switching control means of the mobile communication terminal performs the mode switching control based on the switching signal received from the server.

However, the preceding limitation is known in the art of communications. Hamberg teaches receiving authorization over the cellular network prior to upload a tag on a paint wall [0031-0035] (i.e., receiving a trigger from the network to upload a tag to another device performs the function of switching control means. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Hamberg within the system of Dadong in order that the subscriber of a mobile terminal can request permission over the cellular network to upload, via the Bluetooth, advertisements to a communication device. Thus, increasing the performance of the mobile terminal.

Regarding claim 15, Hamberg in view of Dadong teaches all the limitations above. Hamberg further teaches wherein at least one of the mobile communication terminal and the server further comprises authentication means for authenticating whether a mini-communicator is a qualified one [0031-0035].

Allowable Subject Matter

8. Claims 2-6, 10, 13, 14, and 17-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments filed 12/10/03 have been fully considered but they are not persuasive.

The Applicant argues that Dadong does not specifically teach means for receiving a switching signal for switching among a plurality of modes comprising an identification information receive mode activating only the means for receiving identification information, and a cellular communication mode activating only the cellular communication means for communicating, and for performing a mode switching control based on the received switching signal.

However, the Examiner disagrees with the preceding arguments. Dadong teaches a controller for controlling the operation of a mobile terminal which includes an RF receiver for receiving product identifying information (at this time the mobile terminal

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is in the state of receiving information corresponding to activating only means for receiving identification information, col. 4, line 51 to col. 5, line 9, and col. 6, lines 1-15), a wireless transceiver for communicating the product identifying information for communicating product information through a wireless network (corresponding to cellular communication mode, col. 6, lines 17-31); the controller performs the switching means for receiving the product information and transmitting the product information to the wireless network for purchasing purpose (i.e., the controller for controlling the operation of the mobile, col. 4, line 51 to col. 6, line 31). The Examiner maintains that the mobile terminal of Dandong performs the same function as the mobile terminal of the claimed invention. Therefore, the rejection is maintained.

The Applicant further argues that Hamberg does not teach means for transmitting to the user's device a switching signal according to a predetermined mode switching request. However, the Examiner disagrees with the preceding arguments. Hamberg teaches that the user of the mobile terminal makes a request and in response the server returns an SMS payment token to the user's device over the cellular telephone, then the user can upload a tag to paint the wall, which can be communicated to another device via Bluetooth ([0032] and [104]-[109]). The teaching of Hamberg inherently includes a controller for performing the switching such as switching to receive the request information via the cellular network and switching to transmit the upload tag to another device via a Bluetooth communication. Therefore, the mobile terminal of Hamberg includes the features of the claimed invention, and is capable of performing the same function as the Applicant's claimed invention. The rejection is maintained.

The Applicant further argues that Dandong does not teach the means for transmitting a switching feature signal feature. However, the preceding limitation is known in the art of communications. Hamberg teaches receiving authorization over the cellular network prior to upload a tag on a paint wall [0031-0035] (i.e., receiving a trigger from the network to upload a tag to another device performs the function of switching control means. The Examiner maintains that when the mobile receives an order from the cellular network to perform certain functions like transmitting a tag to another device is equivalent to the means for transmitting a switching signal. Therefore, the rejections are maintained as recited above, and the Office Action is final.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hoshimo et al.

US 2003/0095032

05/22/2003

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

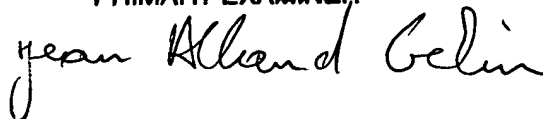
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A. Gelin whose telephone number is (571) 272-7842. The examiner can normally be reached on 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Banks-Harold Marsha can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGelin
August 2, 2006

JEAN GELIN
PRIMARY EXAMINER

A handwritten signature in cursive script that reads "jean alexand gelin". The signature is written in black ink and is positioned below the printed name and title of the examiner.